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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,533	02/07/2002	Mark D. Michaud	12350.0010.NPUS00	1312

7590

12/19/2003

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EXAMINER

NGUYEN, DUNG V

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 12/19/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,533

Applicant(s)

MICHAUD ET AL.

Examiner

Dung V Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 28-35 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 9-26 and 37-41 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8, 27 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 28-35 and 42-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

2. Applicant's election with traverse of invention I, claims 1-27 and 36-41 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the examiner will not be subjected to multiple searches and does not constitute an undue burden. This is not found persuasive because each invention would have to be searched and considered separately thereby posing a significant burden to the examiner. Although all claims are drawn to a process, special feature of each invention is independent of each other as detailed in the restriction requirement and are patentably distinct from each other.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the root filler and housing must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: typo errors, page 12, line 10 and 29, "Figure 1" should be "Figure 2" and page 14, lines 11 and 30, "Figure 2" should be "Figure 1". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 7, 9-26 and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlf (USPN 4,181,540). Ahlf discloses a process comprising providing a tool, introducing an active chemical onto a workpiece, the active chemistry being capable of reacting with the workpiece to form a conversion coating on the workpiece, the conversion coating being insoluble in the active chemistry such that the conversion coating protects the workpiece from further reaction, contacting the tool with the workpiece with a relative motion therebetween, until a desired surface property of the workpiece is reached, wherein the contact between the tool and the workpiece removes the conversion coating from the workpiece, thereby exposing the workpiece to further reaction with the active chemistry such that the conversion coating is allowed to reform on the workpiece, wherein the surface property of the workpiece is surface finishing, wherein the active chemistry is water-based, wherein the active chemistry comprises active ingredients of phosphate salts, chromates, wherein the active chemistry is introduced onto the workpiece with a diluent of water, wherein the workpiece is formed

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from a metal, wherein the conversion coating comprises a compound of phosphate of the metal and a chromate of the metal, wherein the metal is iron, wherein the relative motion between the workpiece and the tool is caused by moving the tool across the workpiece, wherein the tool or the workpiece is stationary, wherein neither the tool nor the workpiece is stationary, wherein the tool is non-abrasive, low abrasive, rigid, flexible, a mating surface of the workpiece, wherein the tool is formed from a non-reactive material, a cloth, wherein the tool is reactive to the active chemistry, wherein the process is carried out at a temperature less than the thermal degradation temperature of the workpiece, wherein the tool is contacted with the workpiece at a force less than the plastic deformation, shear strength, tensile strength of the workpiece, and causes material to be removed from the workpiece less than 0.05 millimeters (note col. 2, line 15 to col. 4, line 21).

Allowable Subject Matter

7. Claims 5, 6, 8, 27 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

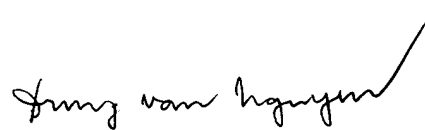
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung V Nguyen whose telephone number is 703-305-0036. The examiner can normally be reached on M-F, 6:30-3:00.

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9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J Hail can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

DVN
December 15, 2003



DUNG VAN NGUYEN
PRIMARY EXAMINER